

**REMARKS**

This Amendment, submitted in response to the Office Action dated February 3, 2004, is believed to be fully responsive to each point of rejection raised therein. Accordingly, favorable reconsideration on the merits is respectfully requested.

As a preliminary matter, the finality of the present Office Action should be withdrawn. The Examiner indicates that the Applicant's amendments to claims necessitated the new grounds of rejection in the present Office Action. The previous amendments to the claims were merely in response to the Examiner's 37 C.F.R. § 112, second paragraph rejections. A second or subsequent action of the merits **should not** be made final if it includes a rejection on prior art not of record, of any claim amended to include limitations which should reasonably have expected to be claimed. For example, one would reasonably expect that a rejection under 37 C.F.R. § 112 would be replied to with an amendment. MPEP 706.07(a). Therefore, the finality of the present Office Action should be withdrawn.

Claims 1-18 are now pending in the present application. Claims 8 and 9 have been objected to but would be allowed if rewritten in independent form. Claims 2 and 7-12 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Claims 1-7 and 10-12 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Chen (U.S. Patent No. 6,438,384) in view of Ditzik (U.S. Patent No. 5,983,073). Applicant submits the following in traversal of the rejections.

***Rejection of claims 2 and 7-12 under § 112, second paragraph, as being indefinite***

The Examiner states that the language “it” and “and/or” in the claims, renders claims 2 and 7-12 indefinite. Claims 2 and 7-12 have been amended as indicated above. Applicant submits that the claims are in proper form. Consequently, the rejection of claims 2 and 7-12 under § 112, second paragraph should be withdrawn.

***Rejection of claims 1-7 and 10-12 under § 103(a) as being unpatentable over Chen in view of Ditzik***

An exemplary embodiment of the present invention discloses a portable terminal and a radiotelephone terminal which allows a user to enter instructions through a keypad and view the keys being entered. At the same time, the user can keep the portable terminal to their ear and mouth for speaking and listening.

Chen pertains to a telephone with a built-in modem device for voice communications over the Internet. In Chen, there is no need to disconnect a telephone line between a modem and a telephone instrument when making a regular telephone call or when using the Internet. See col. 1, lines 18-25. The telephone will convert voice communications over the Internet and will convert communications from the Internet to the telephone.

Chen pertains to the conversion of voice communications through the Internet. Chen does not pertain to a system for entering keys and viewing the entered keys on a display for a portable terminal and a complementary radiotelephone terminal.

The Examiner cites Chen cordless handset unit 20 for teaching the portable terminal of claim 1. The Examiner asserts that the handset unit 20 of Chen communicates by radio with data network terminal 30, citing Fig. 2, col. 1, line 63 to col. 2, line 31.

However, the portable terminal of claim 1 is configured to be carried by a user thereby allowing the user to communicate by radio with a communication network *via a relay transceiver station*. Upon viewing Fig. 2 of Chen, it appears that the handset unit 20 communicates with the data network terminal 30 via a modem device 12 and not a relay transceiver station as claimed. A modem device is not a relay transceiver station as would be apparent to one of skill in the art.

The Examiner cites Chen telephone base unit 10 for teaching a radiotelephone terminal which is complementary to the portable radiotelephone terminal and that the radiotelephone terminal is used conjointly with the portable terminal when connected to *the relay transceiver station* by a call set up via the relay transceiver station.

However, there is no indication that the telephone base unit 10 and the cordless handset unit 20 are used conjointly when connected to a relay transceiver station by a call set up via the station. In particular, it does not appear that the calls are set up via the modem device (relay transceiver station as cited by the Examiner) and that the telephone base unit and cordless handset unit are used conjointly when connected to the modem device by a call set up.

The Examiner indicates that a relay transceiver is not specifically disclosed in Chen and cites Ditzik, col. 2, lines 45-65 and Fig. 7, to cure the deficiency. The respective column and lines cited by the Examiner describes hardware and program software to control cellular or PDA

communications combined with a light weight mobile notebook or PDA unit. The PDA unit or system would act as a computing platform and base communications relay station. It appears the Examiner is citing the base communications relay station of Chen for teaching the relay transceiver station of claim 1.

However, there is no indication that the cordless handset unit of Chen communicates through a relay transceiver station and that the telephone base unit is used *conjointly* with the cordless handset unit when connected to the relay transceiver station by a call set up by the relay transceiver station. Any suggestion by the Examiner that the combination is obvious would merely be a result of hindsight. In particular, the modification of Chen to include the relay station of Ditzik would require a substantial reconstruction of the principle operation of Chen, evidencing that the Examiner's reasoning is merely a result of hindsight. MPEP 2143.01.

Furthermore, there is no indication that that the relay station of Ditzik can be used conjointly between a portable terminal and a complementary radiotelephone terminal. Ditzik pertains to a portable personal computer system or PDA. The relay station of Ditzik is used for a single PDA or notebook computer. Therefore, it is unlikely that one of ordinary skill in the art would combine aspects of Ditzik with Chen.

For the above reasons claim 1 and its dependent claims should be deemed patentable. Since claim 7 recites similar elements, claim 7 and its dependent claims are patentable for the same reasons.

**Claim 2**

Claim 2 recites that the portable terminal and the radiotelephone terminal are equipped with man-machine interface means and software means which are at least partly complementary.

The Examiner cites Chen Fig. 2 and col. 1, line 63 to col. 2, lines 31 for teaching the elements of claim 2. However, there is no indication that the cordless handset 20 of Chen includes a man-machine interface **and** software means as recited in claim 2. Therefore, claim 2 should be deemed patentable.

**Claim 3**

Claim 3 recites that the portable terminal and the radiotelephone terminal include transceiver means and software means. Claim 3 further recites that the portable terminal and the radiotelephone terminal communicate by radio with a relay transceiver station of the communication network and that the communication is via a respective different radiotelephone link during a call involving the portable terminal.

The Examiner cites Figs. 2 and 9 and col. 8, lines 8-40 of Chen for teaching claim 3. It appears that the Examiner is now citing the data network terminal of Chen for teaching the relay transceiver station of claim 1. The data network terminal is not a relay transceiver station, as claimed.

Furthermore, the data network terminal was previously cited for teaching the communication network. The Examiner has double counted the data network terminal for teaching two different elements of the claimed invention. Since the Examiner has not

established that all of the claimed elements are taught in the prior art, claim 3 should be deemed patentable.

**Claim 4**

Claim 4 recites that the transceiver means enables the portable terminal to communicate by radio with the relay transceiver station of the communication network via a first link and with a radiotelephone terminal via a second link.

The Examiner cites Figs. 2 and 9 and column 8, lines 8-40 for teaching claim 4. However, there is no indication that the cordless handset unit 20 communicates with the telephone base unit 10 via a first link and that the cordless handset unit 20 communicates with the modem device or data network terminal (relay transceiver station) via a second link. Therefore, claim 4 should be deemed patentable.

Applicant has added claim 13 to provide a more varied scope of protection. Claim 13 further defines the portable terminal. Claim 13 should be deemed patentable by virtue of its dependency to claim 2 for the reasons set forth above.


In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.116  
U.S. APPLN. NO.: 09/740,784

ATTORNEY DOCKET NO. Q62359

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

  
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